



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/573,354

05/10/2007

Richard M. Wright

059742-5002

2805

9629 7590 11/23/2010
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

BASQUILL, SEAN M

ART UNIT

PAPER NUMBER

1613

MAIL DATE

DELIVERY MODE

11/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,354	Applicant(s) WRIGHT ET AL.	
	Examiner Sean Basquill	Art Unit 1613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-14, 16-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) 4, 13, 19 and 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7-12, 14, 16-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1613

DETAILED ACTION

Status of the Claims

1. Claims 1, 7, and 16 have been amended, and Claims 6, 15, and 21 cancelled. Claims 4, 13, 19, and 22-25 remain withdrawn as directed to nonelected inventions. Claims 1-3, 5, 7-12, 15, 16-18, and 20 are presented for examination.

Previous Rejections

2. Applicants' arguments, filed 22 September 2010, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-3, 5, 7-12, 14, 16-18, and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by F. Chabot, *et al*, *Reactive Oxygen Species in Acute Lung Injury*, 11 EUR. RESPIR. J 745, 750-53 (1998) ("Chabot").

As a threshold matter, the examiner has considered the amendments to the instant claims presented by the applicants, specifically the inclusion in independent Claims 1, 7, and 16 of language indicating "selecting [for] a subject suffering from inflammation caused by increased

Art Unit: 1613

xanthine oxidoreductase activity in leukocytes and leukocyte precursor cells...,” in terms of modifying the scope of the invention claimed and therefore the applicability of the art previously cited to the instant claims. The examiner notes that, in the independent claims, this language serves to categorize the subjects serving as the patient population treatable by the methods described. This scope of treatable patients is further modified by dependent claims 3, 5, 12, 14, 18, and 20, which indicate quite clearly that patients suffering from, for example, acute lung injury would, as dependent claims must incorporate the limitations of the claims from which they depend, necessarily suffer from inflammation caused by increased xanthine oxidoreductase activity in leukocytes and leukocyte precursor cells. Therefore, selecting a patient suffering from an acute lung injury would necessarily incorporate selecting a patient suffering from inflammation caused by increased xanthine oxidoreductase activity in leukocytes and leukocyte precursor cells.

Applicants arguments have been fully considered and are deemed unpersuasive. As discussed above, by selecting a patient suffering from an acute lung injury, such as that caused by the ischemia-reperfusion injuries detailed in Chabot, the skilled artisan would necessarily have selected a patient suffering from inflammation caused by increased xanthine oxidoreductase activity in leukocytes and leukocyte precursor cells. Chabot clearly describes the treatment of such injuries by the administration of the xanthine oxidoreductase inhibitor allopurinol to patients suffering from such injury. Applicants inclusion of claim language relating to “inflammation caused by increased xanthine oxidoreductase activity in leukocytes and leukocyte precursor cells” appears to be nothing more than the applicants recognition, quantification, and recitation of an additional property or advantage necessarily present in the prior art. Such

Art Unit: 1613

activity cannot serve as the basis of a patentable invention. *See* MPEP 2111.02 (indicating that when claims recite using an old composition and the use is directed to a result or property of the composition, the claim is anticipated).

Conclusion

No Claims stand allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Basquill whose telephone number is (571) 270-5862. The examiner can normally be reached on Monday through Thursday, between 8AM and 6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Kwon can be reached on (571) 272-0581. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1613

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sean Basquill/
Examiner, Art Unit 1613

/Jeffrey S. Lundgren/
Primary Examiner, Art Unit 1639